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| 10/618,867 | 07/14/2003 | Gary E. Sullivan | P1544US01 | 6958 |

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| EXAMINER | |
|---|---|
| TRAN, TRANG U | |
| ART UNIT | PAPER NUMBER |
| 2622 | |

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/618,867 | SULLIVAN ET AL. | |
| | Examiner | Art Unit | |
| | Trang U. Tran | 2622 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *03 November 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-36* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *27-36* is/are allowed.

6)☒ Claim(s) *1-26* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments filed Nov. 03, 2006 have been fully considered but they are not persuasive.

In re pages 10-13, applicant argues, with respect to claim 1, that nothing in Goode et al describes or leads one of ordinary skill in the art to the requirement of claim 1 that "a subject matter of said specific encoded video signal being based upon relevance of said encoded video signal to either a subject matter of content displayed by the first video source prior to the transition or a subject matter of content selected for display via a second video source following the transition".

In response, the examiner respectfully disagrees. Goode et al discloses in col. 3, lines 27-44 that

> "The session manager 104 handles all of the transmission interface requirements of the system 100. **The network can be any one of a number of conventional communications networks that are available such as a hybrid fiber-coax network, telephone network, existing cable television network and the like**. For examiner, if the network is a hybrid fiber-coax network, the transmission transport technique used may be modeled after the Moving Pictures Experts Group (MPEG) transport protocol to transport the information streams from the server to the set top terminals. In general, the transport mechanism for the first forward channel that transports broadband information to the set top terminal must be able to carry unidirectional, asynchronous packetized data, such as that defined in the asynchronous packetized data, such as that defined in the asynchronous transfer mode (ATM) standard, the Moving Picture Experts Group (MPG) standard, and the like. There are many such broadband forward channel transport mechanisms available" and in col. 4, lines 21-23 that
>
> "Any video data carried within the program streams via the forward channel is generally compressed using either MPEG-1 or **MPEG-2 compression**".

It is noted that MPEG-2 standard having I, P, and B frames. The I, P, B frames are based upon relevance of the content of the video signal. Thus, the claimed "a subject matter of said specific encoded video signal being based upon relevance of said encoded video signal to either a subject matter of content displayed by the first video source prior to the transition or a subject matter of content selected for display via the second video source following the transition" is met by the conventional MPEG-2 compression of Goode et al.

In re pages 13-14, applicant argues, with respect to claim 7, that nothing in Goode et al discloses "wherein said overlaying means overlay the decoded video signal of said alternate decoding means during the transition when said decoding means is unavailable during the transition".

In response, the examiner respectfully disagrees. As discussed above with respect to claim 1, the MPEG-2 standard has I, P, and B frames. MPEG-2 decoder has three decoders, I decoder, P decoders, and B decoder. When overlaying decoded I frame, the P and B decoders are unavailable, when overlaying decoded P frame, the I and B decoders are unavailable, and when overlaying decoded B frame, the I and P decoders are unavailable. Thus, the overlaying of decoded MPEG-2 of Goode et al anticipates the claimed "wherein said overlaying means overlay the decoded video signal of said alternate decoding means during the transition when said decoding means is unavailable during the transition".

In re page 15, applicant argues, with respect to claim 8, that there is no support for the contention that the incorporation of the Jernigan commercials into Goode would actually result in "a significant lower cost to the advertiser".

In response, the examiner respectfully disagrees. Jernigan et al discloses in col. 1, lines 8-10 that "The invention relates to method and apparatus for providing commercial advertising in a television receiver" and in col. 1, lines 29-32 that "It is an object of the present invention to provide a method and apparatus by which commercial advertisements may be delivered to the consumer at a significantly lower cost to the advertiser". It is noted that Goode et al also discloses the television receiver. Both Goode et al and Jernigan et al discloses television receiver and Jernigan et al teaches an advantage of significantly lower cost to the advertiser. There is support in Jernigan the motivation of combining the two references.

In re pages 15-17, applicant argues, with respect to claim 14, that nothing in Goode patent discloses or suggests that the Goode system is "capable of extending the transition".

In response, the examiner respectfully disagrees. Goode et al discloses in col. 4, lines 57-61 that "FIG. 2 depicts a flow chart of the latency masking routine 200 of the present invention that is implemented in software and executed by the CPU within the set top terminal. This latency mashing routine is executed whenever a customer selects a particular function that will result in latency, e.g..." It is noted that the customer selects particular function. Since customer selects function, the customer cans extent the transition.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 3-4, 6-7, 10-14, 16-17, 19-20 and 23-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Goode et al (US Patent No. 5,781,227).

In consider claim 1, Goode et al discloses all the claimed subject matter, note 1) the claimed means for providing an output to a display in response to an input signal received from a video source, said output providing means including means for buffering the input signal is met by the set top terminal 108 which receives the video program stream via a forward channel, processes the decompressed information for display upon the display unit 110 (Fig. 1, col. 4, lines 5-33), 2) the claimed means for decoding an encoded video signal into a decoded video signal is met by the decoder 130 (Fig. 1, col. 4, lines 34-56), 3) the claimed means, coupled to said output providing means, for overlaying the decoded video signal decoded by said decoding means onto the display during a transition when said output providing means switches from a first video source to a second video source is met by the display of such function information is generally handled by recalling a particular bit map image, overlay image, or on-screen display (OSD) graphic from the image memory for display upon the display unit during a transition period when switch from first video sequence to the second video sequence (Fig. 1, col. 3, line 54 to col. 4, line 19), and 4) the claimed wherein said apparatus

comprises a plurality of encoded video signals, said apparatus being capable of selecting a specific encoded video signal for decoding and display during the transition, a subject matter of said specific encoded video signal being based upon relevance of said encoded video signal to either a subject matter of content displayed by the first video source prior to the transition or a subject matter of content selected for display via the second video source following the transition is met by the generating a predefined images which stores in the image memory 128 that contains a plurality of bit map images, the bit map images can be selectively display, vide clips, audio clips, animation, graphical images and the like (Fig. 1, col. 3, lines 27-44 and col. 4, line 21 to col. 5, line 63).

In consider claim 3, the claimed said decoding means comprising a decoder compliant with an MPEG standard is met by the MPEG decoder 103 (Fig. 1, col. 4, lines 5-56).

In consider claim 4, the claimed said overlaying means comprising a video overlay is met by the display of such function information is generally handled by recalling a particular bit map image, overlay image, or on-screen display (OSD) graphic from the image memory for display upon the display unit during a transition period when switch from first video sequence to the second video sequence (Fig. 1, col. 3, line 54 to col. 4, line 19).

In consider claim 6, the claimed said decoding means being capable of receiving the encoded video signal via a network is met by the communications network 106 (Fig. 1, col. 3, lines 1-60).

In consider claim 7, the claimed further comprising an alternate means for decoding an encoded video signal into a decoded video signal wherein said overlaying means overlays the decoded video signal of said alternate decoding means during the transition when said decoding means is unavailable during the transition is met by the display of such function information is generally handled by recalling a particular bit map image, overlay image, or on-screen display (OSD) graphic from the image memory for display upon the display unit during a transition period when switch from first video sequence to the second video sequence (Fig. 1, col. 3, line 54 to col. 4, line 19).

In consider claim 10, the claimed further comprising means for storing an encoded signal such that the encoded signal is available to be decoded by said decoding means upon an occurrence of the transition is met by the generating a predefined images which stores in the image memory 128 that contains a plurality of bit map images, the bit map images can be selectively display, vide clips, audio clips, animation, graphical images and the like (Fig. 1, col. 4, line 34 to col. 5, line 63).

In consider claim 11, the claimed further comprising a memory capable of storing an encoded signal such that the encoded signal is available to be decoded by said decoding means upon an occurrence of the transition is met by the generating a predefined images which stores in the image memory 128 that contains a plurality of bit map images, the bit map images can be selectively display, vide clips, audio clips, animation, graphical images and the like (Fig. 1, col. 4, line 34 to col. 5, line 63).

In consider claim 12, the claimed further comprising a processor for executing a program of instructions that controls the apparatus, said processor being coupled to

said output providing means via a bus is met by the CPU 122 (Fig. 1 and 2, col. 4, line 34 to col. 6, line 30).

In consider claim 13, the claimed wherein said apparatus is capable of extending the transition to a predetermined time duration when said output providing means switches from the first video source to the second video source, thereby ensuring that the decoded video signal is capable of being displayed in its entirety is met by the setting a transition timer within the decoder (Fig. 2, col. 5, line 21 to col. 6, line 30).

In consider claim 14, Goode et al discloses all the claimed subject matter, note 1) the claimed means for providing an output to a display in response to an input signal received from a video source, said output providing means including means for buffering the input signal is met by the set top terminal 108 which receives the video program stream via a forward channel, processes the decompressed information for display upon the display unit 110 (Fig. 1, col. 4, lines 5-33), 2) the claimed means for decoding an encoded video signal into a decoded video signal is met by the decoder 130 (Fig. 1, col. 4, lines 34-56), and 3) the claimed means, coupled to said output providing means, for overlaying the decoded video signal decoded by said decoding means onto the display during a transition when said output providing means switches from a first video source to a second video source is met by the display of such function information is generally handled by recalling a particular bit map image, overlay image, or on-screen display (OSD) graphic from the image memory for display upon the display unit during a transition period when switch from first video sequence to the second video sequence (Fig. 1, col. 3, line 54 to col. 4, line 19), and 4) the claimed wherein said

apparatus is capable of extending the transition to a predetermined time duration when said output providing means switches from the first video source to the second video source, thereby ensuring that the decoded video signal is capable of being displayed in its entirety is met by the setting a transition timer within the decoder (Fig. 2, col. 5, line 21 to col. 6, line 30).

Claims 16-17 are rejected for the same reason as discussed in claims 3-4, respectively.

Claims 19-20 are rejected for the same reason as discussed in claims 6-7, respectively.

Claims 23-25 are rejected for the same reason as discussed in claims 10-12, respectively.

Claim 26 is rejected for the same reason as discussed in claim 1.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 2, 5, 8-9, 15, 18 and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goode et al (US Patent No. 5,781,227) in view of Jernigan et al (US Patent No. 5,233,423).

In considering claim 2, Goode et al discloses all the claimed subject matter, note 1) the claimed said buffering means comprising video memory is met by the image

memory 128 (Fig. 1, col. 4, lines 34-56). However, Goode et al explicitly do not disclose the claimed said output providing means comprising a graphics controller. Jernigan et al teach that a graphics and memory controller 20 is coupled to the micro-controller 16 and the ROM 12 for addressing the ROM 12 under control of the micro-controller 16 and for generating the appropriate graphic images representative of the data being addressed in ROM 12, the output from the graphics and memory controller 20 is applied to a pallet controller 22 (in the event of color) via the data bus 14 which generates the RGB video signal for the particular advertisement (col. 2, lines 35-68). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate a graphics controller as taught by Jernigan et al into Goode et al's system in order to providing the source of image video signal for displayed.

In considering claim 5, Goode et al discloses all the claimed subject matter, note 1) the claimed said buffering means comprising video memory, said decoding means comprising a decoder compliant with an MPEG standard, and said overlaying means comprising a video overlay is met by the image memory 128 and the MPEG decoder 103 (Fig. 1, col. 3, line 54 to col. 4, line 56). However, Goode et al explicitly do not disclose the claimed said output providing means comprising a graphics controller. Jernigan et al teach that a graphics and memory controller 20 is coupled to the micro-controller 16 and the ROM 12 for addressing the ROM 12 under control of the micro-controller 16 and for generating the appropriate graphic images representative of the data being addressed in ROM 12, the output from the graphics and memory controller 20 is applied to a pallet controller 22 (in the event of color) via the data bus 14 which

generates the RGB video signal for the particular advertisement (col. 2, lines 35-68). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate a graphics controller as taught by Jernigan et al into Goode et al's system in order to providing the source of image video signal for displayed.

In considering claim 8, Goode et al disclose all the limitations of the instant invention as discussed in claim 1 above, except for providing the claimed said decoding means being capable of decoding an encoded commercial video signal into a decoded commercial video signal such that said overlaying means overlays the decoded commercial video signal during the transition. Jernigan et al teach that in particular, the method comprises locally storing in said television receiver data representing commercial advertisements, selectively converting said data into video signals, and selectively switching said video signals to the display of said television receiver for a predetermined period of time (col. 1, lines 33 to col. 2, line 68). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the display commercial advertisement as taught by Jernigan et al into Goode et al's system in order to deliver commercial advertisement to the consumer at a significantly lower cost to the advertiser.

In considering claim 9, Goode et al disclose all the limitations of the instant invention as discussed in claim 1 above, except for providing the claimed said decoding means being capable of decoding a video signal containing advertisement information into a decoded commercial video signal containing advertisement information such that said overlaying means overlays the decoded video signal containing advertisement

information during the transition. Jernigan et al teach that in particular, the method comprises locally storing in said television receiver data representing commercial advertisements, selectively converting said data into video signals, and selectively switching said video signals to the display of said television receiver for a predetermined period of time (col. 1, lines 33 to col. 2, line 68). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the display commercial advertisement as taught by Jernigan et al into Goode et al's system in order to deliver commercial advertisement to the consumer at a significantly lower cost to the advertiser.

Claim 15 is rejected for the same reason as discussed in claim 2.

Claim 18 is rejected for the same reason as discussed in claim 5.

Claims 21-22 are rejected for the same reason as discussed in claims 8-9, respectively.

***Allowable Subject Matter***

6. Claims 27-36 are allowed.

The independent claims 27, 31 and 32 identifies the uniquely distinct features: "detecting an a occurrence of the transition from a first video source to a second video source; if an occurrence of a video transition from a first video source to a second video source is detected, then determining if a first decoder is available; and if the first decoder is not available, then selecting a second decoder". The prior arts, Goode et al (US Patent No. 5,781,227) and Jernigan et al (US Patent No. 5,233,423), either

singularly or in combination, fail to anticipate or render the above underlined limitations obvious.

***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Trang U. Tran whose telephone number is (571) 272-7358. The examiner can normally be reached on 8:00 AM - 5:30 PM, Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David L. Ometz can be reached on (571) 272-7593. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

January 22, 2007

Trang U. Tran
Primary Examiner
Art Unit 2622